

Office Action Summary

Application No.

09/359,152

Applicant(s)

PATTON ET AL.

Examiner

Monica J. Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a) because they fail to show reference element 150, "authentic digital image", as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 1 is objected to because of the following informalities: In part c of claim 1, the phrase, "...printing at a designated location accepted digital images...", should be changed to "...printing at a designated location that accepts digital images...".

Appropriate correction is required.

3. Claim 6 is objected to because of the following informalities: the word, "contains", should be changed to "contents". Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Regarding claims 1 and 6, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-5 and 10-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Enomoto et al (U.S. Patent 5,974,401).

Regarding claim 1, Enomoto discloses a method of authorizing the making of images on a receiver such as postage stamps by a receiving agency comprising the steps of: (a) electronically transmitting a digital image file (column 3, lines 40-63) over a channel to the receiving agency (column 3, lines 21-30); (b) the digital image file includes at least one digital image and authorization information (column 3, lines 40-63)

for making images on a receiver (column 4, lines 39-51); and (c) receiving the digital image file at the receiving agency (column 4, lines 52-65), displaying at least one received digital image (column 8, lines 60-65) and examining the displayed digital image to determine whether its contents are acceptable for making images (column 7, lines 32-38; an operator is able to observe the image data and make corrections to it to make the print acceptable for printing) and examining the authorization information (column 7, lines 14-21) and printing at a designated location accepted digital images on a receiver corresponding to the transmitted digital image when the authorization information is approved (column 7, lines 22-23).

Regarding claims 2 and 11, Enomoto discloses the method wherein the transmitted digital image is converted by a display to a visual image which is viewed to determine if it is acceptable (column 8, lines 60-65; an operator is able to observe the image data and make corrections to it to make the print acceptable for printing).

Regarding claims 3 and 12, Enomoto discloses the method wherein the authorization information is examined by logic and control means to determine that whether or not the authorization information is approved (column 7, lines 4-13).

Regarding claims 4 and 13, Enomoto discloses the method wherein the images are printed by a thermal printer, electrophotographic printer, ink jet or photographic printer (column 4, 12-20).

Regarding claims 5 and 14, Enomoto discloses the method wherein the digital image and the authorization information is transmitted over the Internet (column 3, lines 26-30).

Regarding claim 10, Enomoto discloses a method for printing a digital image received at a receiving agency comprising the steps of: displaying at least one received digital image (column 8, lines 60-65) and corresponding authorization information (column 7, lines 14-21) and examining the displayed digital image and authorization information to determine whether their contents are acceptable for making images column 7, lines 32-38; an operator is able to observe the image data and make corrections to it to make the print acceptable for printing). and printing at a designated location accepted digital images on a receiver corresponding to the transmitted digital image (column 7, lines 22-23).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6-9 rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto et al (U.S. Patent 5,974,401) and further in view of Moghadam et al (U.S. Patent Number 5,799,219).

Regarding claim 6, Enomoto discloses a method of authorizing the making of images on a receiver such as postage stamps by a receiving agency comprising the steps of: (a) examining a hardcopy image and authorization information produced at a location remote from the receiving agency to preliminarily determine if the image and

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authorization information is acceptable; (b) scanning the preliminarily accepted hardcopy image, creating a digital image file, the digital image file includes at least one digital image and the authorization information (column 3, lines 40-63) for making images on a receiver (column 4, lines 39-51); and displaying (column 8, lines 60-65) and examining the scanned digital image and the scanned authorization information to determine whether their contains are approved for making images (column 7, lines 32-38; an operator is able to observe the image data and make corrections to it to make the print acceptable for printing) and printing at a designated location accepted digital images on a receiver corresponding to the scanned hardcopy image when the displayed image and the displayed authorization information are approved (column 7, lines 22-23).

However, Enomoto fails to disclose a method of authorizing the making of images on a receiver such as postage stamps by a receiving agency comprising the steps of: (a) examining a hardcopy image and authorization information produced at a location remote from the receiving agency to preliminarily determine if the image and authorization information is acceptable and (b) scanning the preliminarily accepted hardcopy image, creating a digital image file.

Moghadam discloses a method of authorizing the making of images on a receiver such as postage stamps by a receiving agency comprising the steps of: (a) examining a hardcopy image and authorization information produced at a location remote from the receiving agency to preliminarily determine if the image and authorization information is acceptable (column 5, lines 34-45); (b) scanning the preliminarily accepted hardcopy image (column 7, lines 45-47), creating a digital image

file, the digital image file includes at least one digital image and the authorization information for making images on a receiver; and displaying and examining the scanned digital image and the scanned authorization information to determine whether their contents are approved for making images and printing at a designated location accepted digital images on a receiver corresponding to the scanned hardcopy image when the displayed image and the displayed authorization information are approved.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the inventions were made to include the teachings of Moghadam with the teachings of Enomoto to provide an interactive networked system and allow customers and customer authorized viewers to preview photofinishing orders.

Regarding claim 7, Enomoto and Moghadam disclose the method discussed in claim 6 and Enomoto further teaches the method wherein the scanned hardcopy image is converted by a display to a visual image which is viewed to determine if it is acceptable (column 8, lines 60-65; an operator is able to observe the image data and make corrections to it to make the print acceptable for printing).

Regarding claim 8, Enomoto and Moghadam disclose the method discussed in claim 6 and Enomoto further teaches the method wherein the authorization information is examined by logic and control means to determine that whether or not the authorization information is approved (column 7, lines 4-13).

Regarding claim 9, Enomoto and Moghadam disclose the method discussed in claim 6 and Enomoto further teaches the method wherein the images are printed by a

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thermal printer, electrophotographic printer, ink jet or photographic printer (column 4, lines 12-20).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica J. Mitchell whose telephone number is 703-306-3430. The examiner can normally be reached on Mon.-Fri. from 7:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703-305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-3455 for regular communications and 703-746-3455 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

mjm
November 1, 2002


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